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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/502,810 02/11/00 BRECHER

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EXAMINER

HARTTER, A

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

**Office Action Summary**

Application No.

09/502,810

Applicant(s)

BRECHER, JONATHAN S.

Examiner

Amy Hartter

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

### **Detailed Action**

Applicant's arguments, filed 7/25/01, have been fully considered but are not deemed to be persuasive. Rejections and/or objections are not reiterated from previous Office actions herby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation which has been amended into Claims 1,3, and 4 directed to parsing "non-contiguous" fragments has not been found in the specification as filed and therefore lacks written basis as filed and thus is NEW MATTER in all presently pending claims either directly or via dependence from other claims.

Claims 1-4 and as necessitated by amendment, claims 5, 7-16 and 18-20, are rejected under 35 U.S.C. 112, first paragraph, because Applicant's arguments are not directed to the basis for the rejection which is that inversion only is enabled as a required step and not methods that lack said inversion. The Applicant will note that the arguments are directed to reducing the number of fragments and lacks any comment on whether inversion is a required step or not.

Claim 2 is rejected under 35 U.S.C. 112, first paragraph. It is here noted that nomTokens are described on page 14, but this mention has not aided in pointing to the

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argument to Applicant's arguments. Arguments that are stated on pages 14 and 15 are fails to enable any "conditions" that are cited in Claim 2.

Claims 1-4 and 5-20 as necessitated by amendment are rejected under 35 U.S.C. 112, second paragraph, in that the subject of the nomTokens remains vague and indefinite. The Applicant points to pages 14-30 regarding the usage of said nomTokens. Yet the consideration of these pages has failed to reveal a clear nomTokens definition. The closest description is the formatting line for the NomToken appendix, which is on page 14, line 8. Comparison of this format to even the first NomToken in said appendix is confusing at best. The fitting of this first line to the format is attempted as follows:

Format

Name {/synonym/synonym/...}<space>type<space>subtype<space>data

First NomToken in Appendix

Meth/carbin root alkane C, a/alpha/1/w/omega.

Firstly, there are no brackets or other methods of division in the NomToken Appendix as is displayed above that would make the format more distinct and clear. Secondly, it is not seen how the "meth" term has the following synonyms: "carbin root alkane C, a", "alpha"; "1"; or "w". Thirdly, after the last "I" the word "omega" apparently corresponds to the format section given as "<space>type<space>subtype<space>data". It is not made clear whether the omega is defined as the "type" "subtype" or "data".

Claims 1-4 and claims 5, 7-12, 15, 16 and 18-20 as necessitated by amendment, are rejected under 102(e), based on Ecker et al. The Applicant proposes that Ecker et

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al. only interprets a "contiguous " set of fragments in contrast to the "non-contiguous" fragment limitations in the instant claims. However this limitation has now been noted as NEW MATTER as discussed above. Therefore the rejection based on Ecker et al. is maintained in anticipation of removal of the NEW MATTER thus leaving the claims rejected as before.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### Conclusion


Any inquiry concerning this communication or earlier communications from this examiner should be directed to Amy Hartter whose telephone number is (703) 305-

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1696. The examiner can normally be reached on Monday-Friday from 8 to 4:30 p.m.  
(Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Patent Analyst, Kim Davis, whose telephone number is (703) 305-3015, or to the technical Center receptionist whose telephone number is (703) 308-0196. The fax number for the organization is (703) 308-0196. The fax numbers for the organization where this application is assigned are (703) 308-4242 or (703) 305-3014.



ARDIN H. MARSCHEL  
PRIMARY EXAMINER